



Attorney Docket No. 27549U

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

**KAUTZ**

Serial No.: 10/589,082

Art Unit: 1625

Filed: September 5, 2006

Examiner: O'DELL, D.

For: **NOVEL GUANIDINYL-SUBSTITUTED HYDROXY-6-PHENYLPHENANTHRIDINES  
AS EFFECTIVE PHOSPHODIESTERASE (PDE) 4 INHIBITORS**

**RESPONSE TO OFFICIAL ACTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Official Action dated March 13, 2008. The three-month shortened statutory period for response expired on June 13, 2008. Accordingly, a Petition for a Three (3)-Month Extension of Time is filed herewith, extending the deadline for Response to September 13, 2008. As such, this Response is timely filed within the time period set by the Examiner.

In view of the following remarks, applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections and allow all claims pending in this application.

**1. Revised Restriction / Election Requirement**

The Official Action states that the Examiner "has rejoined groups I-III to make a new

group I (encompassing the previous groups I-III).” As such, the revised restriction requirement reads as follows:

Group I: claims 1-11, drawn to compounds and compositions reading on claim 1, R7 is (b) or (c) where R11 and R10 or R14 and R15 form piperazine drawn to piperazines; compounds and compositions reading on claim 1, R7 is (b) or (c) where R11 and R10 or R14 and R15 form azocan-1-yl drawn to azocanes; and compounds and compositions reading on claim 1, R7 is (a) or (b) or (c) where R11 and R10 or R14 and R15 are limited to H, alkyl, or cycloalkyl drawn to phenanthridines.

Group II: claim 1-11, drawn to all other compounds and compositions not encompassed by [Group I].

Group III: claims 13-14, drawn to methods of treating “illnesses”, limited in scope to one of the compounds of [Groups I-II].

### **RESPONSE**

Previous Group I was elected in the Response to Restriction Requirement filed January 14, 2008. Applicants affirm their election of Group I, which now encompasses previous Groups I, II and III.

Examination of the scope of claims encompassed by the revised Group I is respectfully requested.

**2. Provisional rejection of claims 1-11 under 35 U.S.C. §103(a)**

The Official Action states that claims 1-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over US 7,329,676 (the '676 patent) in view of US 2006/0116518 (the '518 publication).

**RESPONSE**

Applicants respectfully traverse this rejection. The Examiner has not shown a *prima facie* case of obviousness with respect to the presently rejected claims.

As noted by the Examiner, the '676 patent is only available as prior art against the present application under 35 U.S.C. §102(e). Applicants respectfully note that the '676 patent and the instant application were commonly owned and subject to assignment to the same entity at the time the invention was made. As such, the '676 patent is disqualified as prior art against the presently pending claims under 35 U.S.C. §103(c).

Further, applicants respectfully note that the '518 publication is also only available as prior art against the present application under 35 U.S.C. §102(e). Applicants respectfully note that the '518 publication and the instant application were commonly owned and subject to assignment to the same entity at the time the invention was made. As such, the '518 publication is disqualified as prior art against the presently pending claims under 35 U.S.C. §103(c).

As such, applicants respectfully request that the Examiner reconsider and withdraw this rejection of claims 1-11.

### **3. Rejection of claims 1-11 under doctrine of obviousness-type double patenting**

The Official Action states that claims 1-11 are rejected under the doctrine of obviousness type double patenting over claims 1-14 of US 7,329,676 (the '676 patent) in view of US 2006/0116518 (the '518 publication).

#### **Response**

Applicants respectfully traverse this rejection. Applicants respectfully note that the presently pending claims are not an unlawful extension of patent scope of claims 1-14 of the '676 patent. The Examiner is correct that the scope of claims granted in the '676 patent are different than those of the presently pending application. In particular, the '676 patent lacks any teaching whatsoever of the presently pending R7 substituents. The Examiner points, however, to the disclosure of the '518 publication to remedy this deficiency of the '676 patent claims.

In this regard, the Examiner simply alleges that "one of ordinary skill would be motivated to make the compounds of the invention because he would expect the compounds to have similar properties." However, the Examiner has provided no proof that the ordinary skilled artisan would be so motivated. In particular, the Examiner has not pointed to any teaching contained in the references that would cause the skilled artisan to switch the R7 substituent contained in claims 1-14 of the '676 patent with the corresponding R7 substituent of the '518 publication. Short of such a teaching contained in the reference, the Examiner has failed to demonstrate a *prima facie* case of obviousness-

type double patenting over the '676 patent claims.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

**4. Provisional rejection of claims 1-11 under doctrine of obviousness-type double patenting**

The Official Action states that claims 1-11 are provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over the claims of copending application USSN 10/524,634 (corresponding to the '518 publication, discussed above) in view of the '676 patent.

**RESPONSE**

Applicants respectfully traverse this rejection. Applicants respectfully note that the presently pending claims are not an unlawful extension of patent scope of the presently pending claims of the '518 publication. The Examiner is correct that the scope of claims pending in the '518 publication are different than those of the presently pending application. In particular, the '518 publication lacks any teaching whatsoever of the presently pending R4 substituents. The Examiner points, however, to the disclosure of the '676 patent to remedy this deficiency of the presently pending '518 publication claims.

In this regard, the Examiner simply alleges that "one of ordinary skill would be motivated to make the compounds of the invention because he would expect the

compounds to have similar properties.” However, the Examiner has provided no proof that the ordinary skilled artisan would be so motivated. In particular, the Examiner has not pointed to any teaching contained in the references that would cause the skilled artisan to switch the R4 substituent contained in the pending claims of the ‘518 publication with the corresponding substituent of the ‘676 patent. Short of such a teaching contained in the reference, the Examiner has failed to demonstrate a *prima facie* case of obviousness-type double patenting over the ‘518 publication.

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this provisional rejection.

#### **5. Additional double patenting issues**

The Official Action, on page 9, paragraph #7, states that “the examiner has identified fifteen applications with the inventor in common, all with similar titles and subject matter...The burden is now shifted to the applicant to provide information regarding any instance of double patenting in view of the rejections above.”

#### **RESPONSE**

Applicants have reviewed the claims of the pending applications listed by the Examiner and respectfully submit that none of these applications contain any better potential double patenting rejections than already made by the Examiner in the present Official Action.

**CONCLUSION**

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw all rejections and allow all pending claims in this application. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

Respectfully submitted,

**THE NATH LAW GROUP**

A handwritten signature in black ink, appearing to read "Gary M. Nath", written over a horizontal line.

Gary M. Nath  
Reg. No. 26,965  
Joshua B. Goldberg  
Reg. No. 44,126  
Sheldon M. McGee  
Reg. No. 50,454  
Customer No. 34375

Date: September 12, 2008

**THE NATH LAW GROUP**

112 S. West Street  
Alexandria, VA 22314

Telephone: (703) 548-6284  
Facsimile: (703) 683-8396

JBG/SMM/ROA.doc